REMARKS

Applicant respectfully requests reconsideration of this application. A RCE accompanies the current response. Claims 1-14 are pending. No claims have been amended, canceled, or added.

The Examiner has rejected claims 1 and 6-9 under 35 U.S.C. §103(a) as being unpatentable over Johnson (US 3,778,662) in view of Roberts (US 4,633,128). Applicant respectfully traverses the rejection. Claim 1 sets forth:

> a first electrode comprising a first **rod** having a first end and a second end, the first end being mounted in the first cap; and
>
> a second electrode comprising a second **rod** having a first end and a second end, the first end of the second rod being mounted in the second cap.

(Claim 1, emphasis added).

As admitted in the Office Action, Johnson fails to disclose a first electrode comprising a first rod nor a second electrode comprising a second rod. However, the Office Action then stated that Roberts discloses a first electrode comprising a first rod and a second electrode comprising a second rod. The Office Action further argued that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the electrode structure of Roberts into the lamp of Johnson in order to provide a simpler, more durable electrode structure. As Applicant previously submitted, modifying Johnson with the rod-shaped electrodes in Roberts would have rendered Johnson unsatisfactory for its intended purpose

because doing so would significantly reduce the surface area of the discharge electrode 19 in Johnson and would lead to lower current, and hence, lower intensity (Response to Office Action mailed July 28, 2006, pp. 6-7). In response to the above explanation, the Office Action asserted that, "a rod structure, while lowering intensity relative to a given potential, is ***not prohibitive*** with respect to providing high-intensity discharge" (Office Action, p.7, third paragraph; emphasis added). Thus, the Office Action concluded that the combination of Johnson and Roberts does not render the resulting lamp unsatisfactory for the intended purpose of Johnson. Applicant respectfully disagrees with the Office Action.

According to Johnson, conventional fluorescent lamps do not compete with high intensity arc lamps because of the low brightness of fluorescent lamps. In order for the total light output of a fluorescent light source to be comparable to an arc light source, a much greater bulb area is required. Luminaries designed to accommodate such a larger area, being comparably larger, are ***prohibitively heavy and expensive***. (Johnson, col. 1, ln. 17-40)

Referring back to the Office Action, the proposed combination of Johnson and Roberts would significantly lower the light intensity of the fluorescent lamp in Johnson. To remain competitive in terms of total light output, the bulb area of the fluorescent lamp in Johnson would have been increased significantly according to Johnson as discussed above, which would have made the fluorescent lamp "prohibitively heavy and expensive" in Johnson's words. Therefore, the proposed modification of Johnson by Roberts renders the fluorescent lamp in Johnson

unsatisfactory for its intended purpose. For at least this reason, one of ordinary skill in the art would not have been motivated to combine Johnson with Roberts. Thus, claim 1 as it stands is patentable over Johnson in view of Roberts. Withdrawal of the rejection is respectfully requested.

Claims 6-9 depend, directly or indirectly, from claim 1. Thus, claims 6-9 are patentable over Johnson in view of Roberts for at least the reason discussed above with respect to claim 1. Withdrawal of the rejection is respectfully requested.

The Examiner has rejected claims 2-5 and 10-14 under 35 U.S.C. §103(a) as being unpatentable over Johnson and Roberts as applied to claim 1 above, and further in view of Waymouth (US 3,728,004). Applicant respectfully traverses the rejection.

For the reason discussed above with respect to claim 1, there is no motivation for one of ordinary skill in the art to combine the references at the time of the invention. Thus, claim 10 is patentable over Johnson in view of Roberts and Waymouth for at least this reason. Withdrawal of the rejection is respectfully requested.

Claims 2-5 and 11-14 depend, directly or indirectly, from claims 1 and 10, respectively, and thus, include all the limitations set forth in claim 1. For at least the reason discussed above with respect to claims 1 and 10, there is no motivation for one of ordinary skill in the art to combine the references at the time of the invention. Thus, claims 2-5 and 11-14 are patentable over Johnson in view of Roberts and Waymouth. Withdrawal of the rejection is respectfully requested.

Applicant respectfully submits that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call C. Teresa Wong at (408) 720-8300.

Pursuant to 37 C.F.R. 1.136(a)(3), Applicant hereby requests and authorizes the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 C.F.R. 1.16 and 1.17, to Deposit Account No. 02-2666.

Respectfully submitted,
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